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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,182	11/30/2000	Niels Mache	450117-02928	5601
20999	7590	03/03/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			LAZARO, DAVID R	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 03/03/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,182

Applicant(s)

MACHE ET AL.

Examiner

David Lazaro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 are pending in this Office Action.
2. Claims 3-9, 11, 14 and 17-21 were amended in the preliminary amendment filed 11/30/2000.

Papers Received

3. Change of Address/Power of Attorney was received on 05/14/2001.
4. Request for the issuance of a filing receipt was received on 04/12/2001.

Priority

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 12/02/1999. It is noted, however, that applicant has not filed a certified copy of the 99 124 149.8 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 11/30/00 has been considered by the examiner.

Specification

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

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The following title is suggested: Unified Instant Messaging System for Heterogeneous Communication Networks.

8. The disclosure is objected to because of the following informalities: The disclosure should contain the appropriate section headings stated in 37 CFR 1.77(b) (See below).

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC
- (e) BACKGROUND OF THE INVENTION.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.

Appropriate correction is required.

9. The disclosure is objected to because of the following informalities:

- a. Page 13 line 30, "MPU" was not previously defined.
- b. Page 14 line 19, "MIAP" was not previously defined.
- c. Page 16 line 6, "Of cause" should be "Of course".

Appropriate correction is required.

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Please note there may be other minor informalities similar to these. The examiner respectfully requests any additional informalities be corrected appropriately.

Claim Objections

10. Claim 1 is objected to because of the following informalities:
- d. The reference numbers used for the 'plurality of gateways' are incorrect. There is no 7 or 8 in drawings.
 - e. "Configured for the reception and/or transmission over" would be more clear as "configured for receiving and/or transmitting over."
- Appropriate correction is required.

11. Claim 14 is objected to because of the following informalities: "Message broker" should be "Message broker unit". Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
13. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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14. Claim 1 recites the limitation "the supplied message" on line 20 of the page.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-18, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,740,230 by Vaudreuil (Vaudreuil). Vaudreuil was provided as part of the IDS submitted by the applicant.

17. With respect to Claim 1, Vaudreuil teaches a system for transmitting messages over a multimedia network from a sending client to a target client, the messages comprising target client information (Col. 1 lines 52-58), the system comprising: a plurality of message gateways (3, 7, 8) (Col. 7 lines 52-65), each message gateway (3, 7, 8) being configured for the reception and/or transmission over at least one dedicated transfer medium (Col. 7 lines 54-59 and Col. 3 line 66 – Col. 4 line 20), and a message broker (1) (Col. 7 line 65 – Col. 8 line 1; note the examiner is interpreting the 'remainder of the software system' on the hub to be the message broker) connected to the message gateways (3,7,8) (Col. 7 line 65- Col. 8 line 1) and being provided with a client database (Col. 8 lines 46-51 and Col. 9 lines 61-65), wherein a first message gateway receives a message from a sending client over a first transfer medium (Col. 10

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lines 37-41 and Col. 12 lines 21-36) and transmits the message and/or an information extracted thereof to the message broker (1), the message broker (1) automatically selects an appropriate second transfer medium depending on the content of the client database (2) and the supplied message and/or an information extracted thereof (Col. 15 lines 13-20 and Col. 19 lines 49-56), and the message is sent to the target client by means of a second message gateway configured for a transmission over the second transfer medium selected by the message broker (1) (Col. 6 lines 46-65).

18. With respect to Claim 2, Vaudreuil teaches all the limitations of Claim 1 and further teaches a common internal message format for the communication respectively between the message broker (1) and the message gateways (Col. 6 line 65 – Col. 7 line 9 and Col. 13 lines 2-15 and Col. 19 lines 36-48)

19. With respect to Claim 3, Vaudreuil teaches all the limitations of Claim 1 and further teaches the message gateways are distributed over the network (See Fig. 1 – note gateways are part of the hub functionality).

20. With respect to Claim 4, Vaudreuil teaches all the limitations of Claim 1 and further teaches the transfer media comprise analog and digital transfer media (Col. 7 lines 49-60).

21. With respect to Claim 5, Vaudreuil teaches all the limitations of Claim 1 and further teaches at least one message processor (4) provided between the first and the second message gateway for further processing the content of the message to be transmitted (Col. 19 line 66 – Col. 20 line 8).

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22. With respect to Claim 6, Vaudreuil teaches all the limitations of Claim 1 and further teaches the client database (2) comprises addresses of clients (Col. 21 lines 41-46), client preferences (Col. 20 lines 9-11) and/or characteristics of the transfer network to the corresponding target client (Col. 20 lines 11-12).

23. With respect to Claim 7, Vaudreuil teaches all the limitations of Claim 1 and further teaches the message broker (1) is designed to furthermore perform processing control (Col. 8 lines 22-65) and/or security processing (Col. 28 lines 63-67).

24. With respect to Claim 8, Vaudreuil teaches all the limitations of Claim 1 and further teaches the message broker (1) is designed to furthermore perform accounting and/or billing (Col. 9 lines 61-65).

25. With respect to Claim 9, Vaudreuil teaches all the limitations of Claim 1 and further teaches a plurality of message brokers (1, 1') is provided (See Fig. 1 – note message brokers are a part of hub functionality).

26. With respect to Claim 10, Vaudreuil teaches all the limitations of Claim 9 and further teaches at least one message broker (1') being connected with a client database (2') with reduced capacity (Col. 7 lines 61-65 and Col. 8 lines 65-67).

27. With respect to Claim 11, Vaudreuil teaches all the limitations of Claim 1 and further teaches the messages respectively contain a non-granted encrypted and a granted non-encrypted part (Col. 28 lines 63-67).

28. With respect to Claim 12, Vaudreuil teaches a message broker unit for a distributed multimedia system, characterized in that it is designed to autonomously select an appropriate transfer medium out of a plurality of transfer media for message

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received from a sending client and to be transferred to a target client (Col. 4 lines 46-49 and Col. 19 lines 49-57), wherein the message broker (1) (Col. 6 lines 46-48) is connected to a client database (2) (Col. 8 lines 46-51 and Col. 9 lines 61-65) and the transfer medium selection is performed depending on target client information and the content of the client database (Col. 20 lines 9-12 and Col. 6 lines 55-59).

29. With respect to Claim 13, Vaudreuil teaches all the limitations of Claim 12 and further teaches the transfer medium selection is performed depending on the target network (Col. 6 lines 55-59), the message type (Col. 20 lines 9-12) and/or client preference contained in the client database (Col. 19 lines 49-56)

30. With respect to Claim 14, Vaudreuil teaches all the limitations of Claim 12 and further teaches the messages respectively contain a non-granted encrypted and a granted non-encrypted part (Col. 28 lines 63-67).

31. With respect to Claim 15, Vaudreuil teaches a method for sending messages over a multimedia network from a sending client to a target client, the message comprising target client information (Col. 1 lines 52-58), the method comprising the following steps: transmitting the message from the sending client to a message broker (1) over a first transfer medium (Col. 6 lines 46-48), and transmitting the message to the target client over a second transfer medium, wherein the second transfer medium can be identical to the first transfer medium (Col. 5 lines 60-66), wherein the message broker (1) selects an appropriate second transfer medium out of a plurality of transfer media depending on the content of a client database (2) (Col. 19 lines 49-56) connected

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to the message broker (1) (Col. 8 lines 46-51 and Col. 9 lines 61-65) and the target client information (Col. 19 lines 49-56 and Col. 20 lines 9-12).

32. With respect to Claim 16, Vaudreuil teaches all the limitations of Claim 15 and further teaches the transmission of the message from the sending client to the target client is performed essentially in real-time (Col. 24 line 63 – Col. 25 line 3).

33. With respect to Claim 17, Vaudreuil teaches all the limitations of Claim 15 and further teaches a conversion from the first transfer medium to the second transfer medium is performed depending on the target network (Col. 6 lines 55-59), the message type (Col. 20 lines 9-12) and/or client preference contained in the client database (Col. 19 lines 49-56).

34. With respect to Claim 18, Vaudreuil teaches all the limitations of Claim 15 and further teaches before the transmission to the target client, the content of the message is further processed by digital signing, encryption, watermarking and/or translation (Col. 32 lines 57-64 and Col. 28 lines 63-67).

35. With respect to Claim 20, Vaudreuil teaches all the limitations of Claim 15 and further teaches the messages respectively contain a non-granted encrypted and a granted non-encrypted part (Col. 28 lines 63-67).

36. With respect to Claim 21, Vaudreuil teaches all the limitations of Claim 15 and further teaches that when loaded into a computer, it implements a method according to Claim 15 (Col. 7 lines 47-49 and Please refer to Claim 15 rejection).

Claim Rejections - 35 USC § 103

37. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

38. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vaudreuil in view of U.S. Patent 6,163,796 by Yokomizo (Yokomizo). Vaudreuil teaches all the limitations of Claim 15 but does not explicitly disclose a lifetime is attributed to each message and transmitting the message only during that lifetime. Yokomizo teaches a message can have a lifetime attributed to it (Col. 6 lines 4-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Vaudreuil and modify it as indicated by Yokomizo such that a lifetime is attributed to each message and the message is only transmitted until the expiration of the lifetime. One would be motivated to have this as this provides better efficiency in the messaging system (Col. 2 lines 5-9).

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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40. U.S. Patent Application Publication 2003/005974 by Brophy et al. "Systems and methods for providing unified multimedia communication services". March 20, 2003.
Object oriented framework for a unified instant messaging system.
41. U.S. Patent 6,463,462 by Smith et al. "Automated system and method for delivery of messages and processing of message responses". October 8, 2002
42. U.S. Patent 6,421,707 by Miller et al. "Wireless multi-media messaging communications method and apparatus" July 16, 2002
43. U.S. Patent 6,373,926 by Foladare et al. "Centralized message service apparatus and method" April 16, 2002
44. U.S. Patent 6,072,862 by Srinivasan "Adaptable method and system for message delivery" June 6, 2000. Unified messaging system with preferred client device for delivery of message.
45. U.S. Patent 5,987,100 by Fortman et al. "Universal mailbox" November 16, 1999.
Unified message storage with automatic format conversion based on client preference.
46. U.S. Patent 5,951,638 by Hoss et al. "Integrated multimedia messaging system" September 14, 1999. Synchronizes with existing messaging systems to provide a integrated system.
47. U.S. Patent 5,742,668 by Pepe et al. "Electronic messaging network" April 21, 1998. Operates as an interface between wireline and wireless messaging networks. Client message delivery and receipt options are stored in a database.
48. U.S. Patent 5,680,551 by Martino, II. "Electronic messaging method of and system for heterogeneous connectivity and universal and generic interfacing for

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distributed applications and processes residing in wide variety of computing platforms and communication transport facilities." October 21, 1997

49. U.S. Patent 5,377,191 by Farrell et al. "Network communication system"

December 27, 1994. Provides a server system with gateways to send and receives messages for each respective network interface type. Also communicates in a common internal format.

50. U.S. Patent 6,212,550 by Segur. "Method and system in a client-server for automatically converting messages from a first format to a second format compatible with a message retrieving device" April 3, 2001

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 703-305-4868. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Lazaro
February 27, 2004



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER